

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Michael Kaplan et al. Art Unit : 2177
Patent No. : 8,166,384 Examiner : Quoc A. Tran
Issue Date : April 24, 2012 Conf. No. : 7627
Serial No. : 09/594,054
Filed : June 14, 2000
Title : ENVIRONMENT-BASED BOOKMARK MEDIA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF DECISION REGARDING
PATENT TERM ADJUSTMENT

This request for reconsideration is filed in response to the Decision on Request for Reconsideration of Patent Term Adjustment (“the Decision”) dated November 1, 2012. The Decision maintained that the present patent is entitled to 2,957 days of Patent Term Adjustment (PTA). Patentees maintain that the patent is entitled to 3,875 days of PTA, for the reasons provided below. The Decision noted that the patent term adjustment calculation for this patent was implicated by ongoing rulemaking by the U.S. Patent and Trademark Office and provided patentee a period of two months from the date of the decision to file a request for reconsideration of patent term adjustment in light of the final rule, *Revision of Patent Term Adjustment Provisions Relating to Appellate Review*.

Under the rules in effect at the time of the calculation in the instant matter, excluding the period consumed by appellate review, whether successful or not, the Office properly excluded from the calculation of B delay, the period after the filing of the Notices of Appeal filed on July 7, 2004, and December 22, 2005. See 35 U.S.C. 134(a) and 35 U.S.C. 154(b)(1)(B)(ii). Thus there is no patent term adjustment for the periods

between the filing of the Notices of Appeal and the mailing of the subsequent Office Actions.

CERTIFICATE OF (A) MAILING BY FIRST CLASS MAIL OR (B) TRANSMISSION
I hereby certify under 37 CFR §1.8(a) that this correspondence is either (A) addressed as set out in 37 CFR §1.1(a) and being deposited with the United States Postal Service as first class mail with sufficient postage, or (B) being transmitted by facsimile in accordance with 37 CFR § 1.6(d) or via the Office electronic filing system in accordance with 37 CFR § 1.6(a)(4), on the date indicated below.

December 31, 2012

Date of Deposit or Transmission

/Susan C. Johnson/

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Susan C. Johnson

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Patentee is advised however, that the final rule, *Revision of Patent Term Adjustment Provisions Relating to Appellate Review* (77 FR 49354) issued on August 16, 2012. Based on patentee having made this timely request for patent term adjustment based on proposed changes to the Office's former interpretation of 35 U.S.C. 154(b)(1)(B)(ii) and (C)(iii), patentee is given a two-month period from the date of this decision limited to reconsideration of the Office's former interpretation of the appellate review language of 35 U.S.C. 154(b)(1)(B)(ii) and (C)(iii), in light of the final rule, Revision of Patent Term Adjustment Provisions Relating to Appellate Review (77 FR 49354) issued on August 16, 2012.

U.S. Patent No. 8,166,384, was accorded 2,957 days of patent term adjustment. This patent term adjustment award excluded from B Delay the period from the filing of a notice of appeal on November 5, 2004, to the mailing of a non-Final Office Action on March 1, 2005. In the instant case, the entire period beginning on June 15, 2003 (the day after the date that is three years after the date on which the application was filed), and ending April 24, 2012 (the date the patent was issued) - a period of 3,237 days – should thus be considered in the calculation of “B Delay.” Patentees respectfully request that the period of time erroneously deducted from the period of “B Delay” be restored in its entirety to the period of “B Delay.” “B Delay” for this patent is therefore calculated as 3,237 days. The Office calculated only 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the Office’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 3,237 days. In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 3,237 days.

See 37 C.F.R. §§ 1.702(b) and 1.703(b).

In view of the recent rule revision relating to 37 CFR § 1.703(b)(4), Revision of Patent Term Adjustment Provisions Relating to Appellate Review (77 FR 49354) issued on August 16, 2012, the period to be excluded from B Delay begins on the date on which jurisdiction over an application passes to the Board and ends on the later of the date that jurisdiction by the Board ends or the date of the last decision by a Federal court. Because the application that gave rise to the present patent was allowed without jurisdiction over the application passing to the Board, no B Delay exclusion should have occurred for the period

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between the filing of a notice of appeal (November 5, 2004) and the mailing of a non-Final Office Action (March 1, 2005).

In view of the foregoing, Patentees respectfully request that the patent term adjustment be increased by a period of 2,957 days, for a revised patent term adjustment award of 3,875 days.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing attorney docket no. 07844-0427001.

Respectfully submitted,

Date:December 31, 2012

/Spencer C. Patterson/

Spencer C. Patterson
Reg. No. 43,849

Fish & Richardson P.C.
Customer Number 21876
Telephone: (214) 747-5070
Facsimile: (877) 769-7945

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